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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92067794
Party	Defendant The Burton Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Reg. No. 2,207,535 issued on December 1, 1998  
and Reg. No. 3,598,502 issued on March 31, 1999

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Joshua S. Schoonover,	:	
	:	
Petitioner,	:	Cancellation No. 92067794 (parent)
	:	Cancellation No. 92069499
-against-	:	
	:	
The Burton Corporation	:	
	:	
Registrant.	:	
-----X		

**REGISTRANT’S TRIAL BRIEF**

Pursuant to TBMP § 801.02(b), Registrant, The Burton Corporation (“Registrant”) hereby submits its trial brief in the above-captioned consolidated proceeding commenced by Joshua S. Schoonover (“Petitioner”) to cancel U.S. Registration Nos. 2,207,535 and 3,598,502 (collectively, the “FORUM Marks”). For the reasons stated herein, Registrant respectfully requests that the petition to cancel be DENIED.

Date: June 14, 2021

Respectfully submitted,

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## **DESCRIPTION OF THE RECORD**

The evidence of record filed by Registrant is as follows:<sup>1</sup>

**31 TTABVUE**: Certified Transcript of Registrant’s Oral Trial Deposition of Toby F. Bost, including Exhibits 1-2 thereto, filed December 18, 2020.

**33 TTABVUE (public) / 37 TTABVUE (confidential)**: Testimony Declaration of Steven Cooley, including Exhibits 1-2 thereto, filed December 18, 2020. Mr. Cooley’s declaration and exhibits are relevant to Registrant’s use of the FORUM Marks.

**34 TTABVUE (public) / 38 TTABVUE (confidential)**: Testimony Declaration of Christopher L. Cunningham, including Exhibits 1-4 thereto, filed December 18, 2020. Mr. Cunningham’s declaration and exhibits are relevant to Registrant’s use of, and intent to use, the FORUM Marks.

**35 TTABVUE (public) / 39 TTABVUE (confidential)**: Testimony Declaration of Eric Gaisser, including Exhibits 1-4 thereto, filed December 18, 2020. Mr. Gaisser’s declaration and exhibits are relevant to Registrant’s use of, and intent to use, the FORUM Marks.

**36 TTABVUE (public) / 40 TTABVUE (confidential)**: Testimony Declaration of Mark D. Wakeling, including Exhibits 1-5 thereto, filed December 18, 2020. Mr. Wakeling’s declaration and exhibits are relevant to Registrant’s use of, and intent to use, the FORUM Marks.

**41 TTABVUE**: Burton’s First Notice of Reliance depicting printouts/screenshots of publicly available webpages for The House Outdoor Gear website pursuant to 37 C.F.R. § 2.122(e) (accessed Apr. 17, 2019), with Exhibits 1-14. This Notice of Reliance is relevant to Registrant’s use of the FORUM Marks in connection with snowboards, boots, and apparel.

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<sup>1</sup> In his opening brief, Petitioner raised no evidentiary objections to Registrant’s trial evidence. Therefore, none may be raised in his reply brief. *See* TBMP § 801.02(c) (“Objections raised for the first time in a reply brief are untimely because they effectively foreclose the adverse party from responding to the objections.”); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1199, 2018 WL 1557301, at \*2 (TTAB 2018) (same).

Furthermore, Petitioner deposed Messrs. Cooley (56 TTABVUE), Cunningham (57 TTABVUE), and Wakeling (58 TTABVUE). Registrant also relies on their trial deposition testimony herein, and other evidence filed by Petitioner.

### **STATEMENT OF THE ISSUES**

1. Whether Registrant discontinued use of the FORUM Marks. This issue is addressed in Section II, *infra*.
2. Assuming *arguendo* that Petitioner has made a *prima facie* showing of abandonment, whether Registrant has rebutted the presumption that it abandoned the FORUM Marks without intent to resume use. This issue is addressed in Section III, *infra*.

## **RECITATION OF FACTS**

Registrant provides a brief summary of the facts in the trial record as follows:

1. Registrant is a corporation organized under the laws of Vermont having a business address in Burlington, Vermont 05401. 1 TTABVUE 3 at ¶ 8; 4 TTABVUE 2 at ¶ 8.<sup>2</sup>
2. Registrant owns U.S. Registration No. 2,207,535 for the mark FORUM (application filing date of November 25, 1996 and registration date of December 1, 1998) in international class 028 for snowboards, snowboards binding, snowboards leashes and accessories therefor. 1 TTABVUE 3 at ¶ 10; 4 TTABVUE 2 at ¶ 10.
3. Registrant owns U.S. Registration No. 3,598,502 for the standard-character mark FORUM (application filing date of July 7, 2005 and registration date of March 31, 2009) in international class 025 for shirts, sweatshirts, hats, beanies, caps, socks, gloves, and belts.<sup>3</sup> 1 TTABVUE 2 at ¶ 5 (Cancellation No. 92069499); 5 TTABVUE 2 at ¶ 5 (Cancellation No. 92069499).
4. Petitioner does not dispute that Registrant engaged in *bona fide* use of the FORUM Marks in U.S. commerce prior to approximately October 2012.
5. From October 23, 2012 through the end of fiscal year 2017, Registrant realized net sales of FORUM products of \$ [REDACTED] worldwide and \$ [REDACTED] in the United States. 33 TTABVUE 3 at ¶ 11-12 & Exs. 1-2 (public); 37 TTABVUE 3 at ¶ 11-12 & Exs. 1-2 (confidential).

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<sup>2</sup> “TTABVUE” citations herein, unless otherwise noted, refer to docket entries in the parent proceeding, Cancellation No. 92067794.

<sup>3</sup> In his opening trial brief, Petitioner does not distinguish between the marks in the two registrations in his discussion of the record evidence. Registrant therefore understands Petitioner to contend that the same record evidence warrants cancellation of both marks.



6. By way of representative example, those sales included a \$188,937.60 sale of 1,619 FORUM-branded products to The House. 36 TTABVUE 2 at ¶ 5 & Exhibit 1 (invoice dated January 7, 2014).

7. Those sales also included a \$11,829.75 sale of 657 items, including FORUM-branded products, to Sound Barrier, *id.* at ¶ 6 & Exhibit 2 (invoice dated November 19, 2013); and a \$2,353.17 sale of 117 items, including FORUM-branded products, also to Sound Barrier, *id.* at ¶ 6 & Exhibit 3 (invoice dated February 26, 2015).

8. Between approximately April 2016 and June 2016, Registrant evaluated a proposal to license FORUM to a third-party. Registrant requested and was provided an outline of such a licensing proposal, as well as a business plan, profit and loss statements, and other materials from this potential partner. Registrant's senior management evaluated this proposal. Ultimately, however, Registrant opted not to enter such a licensing deal. 34 TTABVUE 2-3 at ¶¶ 5-9 & Exhibits 1-3 (public) / 38 TTABVUE 2-3 at ¶¶ 5-9 & Exhibits 1-3 (confidential); 35 TTABVUE 2-3 at ¶¶ 5-8 & Exhibits 1-3 (public) / 39 TTABVUE 2-3 at ¶¶ 5-8 & Exhibits 1-3 (confidential)

9. Also in April 2016, Registrant engaged in discussions with another third-party to exclusively license FORUM for use with sporting goods categories including snowboards, boots, and bindings; clothing and outerwear; bicycles and bicycle gear; footwear; eyewear; watches; and headphones and earbuds. Those discussions developed to the point that it conveyed a licensing proposal via email to Registrant dated April 7, 2016. *Id.* at ¶ 9 & Exhibit 4 (public) / 40 TTABVUE at 2 ¶ 9 & Exhibit 4 (confidential).

10. While Registrant decided not to enter into that particular licensing deal on this occasion, Registrant entered into a deal with The House to sell 100 FORUM snowboards ("Destroyer" and "Youngblood") on a limited release in the winter of 2019. 35 TTABVUE 4 at ¶ 9

& Exhibit 4 (public) / 38 TTABVUE 4 at ¶ 10 & Exhibit 4 (confidential); 34 TTABVUE 4 at ¶ 10 & Exhibit 4 (public) / 39 TTABVUE 4 at ¶ 10 & Exhibit 4 (confidential). Registrant began discussions with The House concerning this potential deal as early as March 29, 2018. 36 TTABVUE 2 at ¶ 10-11 & Exhibit 5 (public) / 40 TTABVUE at 2 ¶¶ 10-11 & Exhibit 5 (confidential).

11. On January 26, 2018, Petitioner filed a petition to cancel U.S. Reg. No. 2,207,535, as well as another mark that is no longer at issue in this proceeding. 1 TTABVUE. In the petition, Petitioner alleged that Registrant had failed to use this mark in commerce for over 3 years. *Id.* at ¶ 11.

12. On September 5, 2018, Petitioner filed a petition to cancel U.S. Reg. 3,598,502. Cancellation No. 92069499, 1 TTABVUE. In the petition, Petitioner alleged that Registrant had abandoned this mark on or about October 23, 2012. *Id.* ¶¶ 9-12.

13. On January 24, 2019, the Board consolidated the two cancellation proceedings (Nos. 92067794 & 92069499). 12 TTABVUE.

14. To date, Petitioner has never moved to amend his pleadings pursuant to Fed. R. Civ. P. 15.

## **ARGUMENT**

### **I. Legal Standard**

Pursuant to the Trademark Act, abandonment occurs when “use [of a mark] has been discontinued with intent not to resume such use. Intent not to resume such use may be inferred from circumstances.” 15 U.S.C. § 1127. “Nonuse for 3 consecutive years shall be *prima facie* evidence of abandonment.” *Id.* “Use” of a mark means the “*bona fide* use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.” *Id.* “A showing of a *prima facie* case creates a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use.” *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010). “The burden then shifts to the trademark owner to produce evidence that he either used the mark during the statutory period or intended to resume use.” *Id.* (internal quotation marks and citation omitted). At the same time, “[t]he burden of persuasion, however, always remains with the [challenger] to prove abandonment by a preponderance of the evidence.” *Id.* (brackets in original).

### **II. Registrant Has Not Discontinued Use of the FORUM Marks**

#### **A. Registrant Has Failed to Establish Nonuse “as Early as” October 2012**

Petitioner first theorizes that Registrant abandoned use of the FORUM Marks on October 12, 2012<sup>4</sup> when it allegedly published a press release announcing the company’s decision to alter the structure of certain company-owned brands, including FORUM. Petitioner maintains that the press release evinced Registrant’s intent to cease commercial use of FORUM and that Registrant did not engage in any *bona fide* use of the marks thereafter. *See* 61 TTABVue 15-17 (contending

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<sup>4</sup> Petitioner previously alleged that Registrant’s period of nonuse began on October 23, 2012. Petitioner now claims that it began as early as October 12, 2012, without explanation for the shift in position.

that Registrant’s “period of non-use began as early as October 12, 2012”). This argument is flatly contradicted by the record.

1. Testimony of Steven Cooley

Steven Cooley, Registrant’s Director of Financial Planning and Analysis, manages and supervises Registrant’s budgeting, managerial reporting, bank reporting, product profitability reporting, and reports directly to Registrant’s Chief Financial Officer. 33 TTABVUE 2 at ¶ 5. Mr. Cooley has been employed at Registrant for over 15 years and works closely with Registrant’s accounting, treasury, and accounts payable functions. *Id.* at ¶¶ 3, 6. He is familiar with and knowledgeable about all facets of accounting and finance at Registrant. *Id.* at ¶ 6. Mr. Cooley testified as to his personal knowledge that Registrant sold products under the FORUM brand both in the United States and internationally well after October 12, 2012. *Id.* at ¶¶ 8-9.

Exhibit 1 to Mr. Cooley’s testimony declaration is a report generated and maintained by Registrant in the regular course of business through its Business Intelligence (BI) database. It contains all orders of FORUM-branded products from October 23, 2012<sup>5</sup> through the end of fiscal year 2013, and for the entirety of fiscal years 2014, 2015, 2016, and 2017. *Id.* at ¶ 9. The headers to Exhibit 1 reflect the fiscal year in which the order was processed, the party that placed the order and its corresponding vendor code, the net value (USD) of the transaction, and the “Sales Organization” to which the order is attributed.<sup>6</sup> *Id.* at ¶ 10. Exhibit 1 to Mr. Cooley’s testimony

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<sup>5</sup> Consistent with Petitioner’s pleadings, Mr. Cooley was instructed to collect sales data as early as October 23, 2012—not October 12, 2012.

<sup>6</sup> Mr. Cooley’s declaration explains that “Sales Organization” is Registrant’s internal method for segmenting sales. Sales Organization “1000” corresponds to the Burton Corporation, which is the United States sales region. The European region is Sales Organization “4000.” Japan is Sales Organization “3000.” Australia is Sales Organization “2000.” Canada is Sales Organization “6000.” 33 TTABVUE 2-3 at ¶ 10.

declaration demonstrates that, between October 23, 2012 and the end of fiscal year 2017,<sup>7</sup> Registrant recognized net sales relating to FORUM products of \$ [REDACTED] worldwide, with \$ [REDACTED] within the United States sales region. 37 TTABVUE 3 at ¶ 11-12 (confidential).<sup>8</sup> This reflects sales in the United States of \$ [REDACTED] through the end of fiscal year 2013, \$ [REDACTED] in fiscal year 2014, \$ [REDACTED] in fiscal year 2015, and \$ [REDACTED] in fiscal year 2016. Robust sales were also made in the Europe, Japan, Australia and Canada regions during these same time periods. *Id.*

2. Testimony of Mark Wakeling

Mark Wakeling, who had oversight over the FORUM brand as North American Sales Director (September 2011 – August 2012) and U.S. Sales Director (August 2012 to May 2018), 36 TTABVUE 1 at ¶ 2, testified in detail as to specific sales of FORUM products he helped complete in calendar years 2013, 2014, and 2015. Consistent with Mr. Cooley’s testimony, Mr. Wakeling testified that “[d]uring Burton’s fiscal years 2013 through 2017, Burton continued to sell FORUM products and I was personally involved in doing so. Indeed, one of my responsibilities during this period as U.S. Sales Director was to sell FORUM inventory in the United States channel.” *Id.* at 2 ¶ 4.

Exhibits 1, 2, and 3 to Mr. Wakeling’s testimony declaration<sup>9</sup> are invoices for substantial “sales of FORUM snowboards (including ‘Youngblood’ and ‘Destroyer’), bindings, boots, and

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<sup>7</sup> Mr. Cooley testified at his trial deposition that “[f]iscal year ends on the Saturday closest to the end of January, so it changes from year to year. Fiscal year 2017 ended January 28, 2017.” 56 TTABVUE 11:1-3.

<sup>8</sup> Exhibit 2 to Mr. Cooley’s declaration reflects the voluminous data set forth in Exhibit 1 in a more digestible chart format. *See* Fed. R. Evid. 1006.

<sup>9</sup> Exhibit 1 to Mr. Wakeling’s testimony declaration was marked “Exhibit 5” at his trial deposition. Exhibit 2 was marked as “Exhibit 7.” Exhibit 3 was marked as “Exhibit 6.” Herein, Registrant will use the exhibit numbers assigned in Mr. Wakeling’s declaration.

other products under the FORUM brand” to Registrant’s vendors. *Id.* at ¶ 7. Exhibit 1, an invoice dated January 7, 2014, *id.* at ¶ 5, documents a sale to a Minnesota-based buyer called The House (a/k/a Active Sports)<sup>10</sup> and shows “the products sold, the unit price, the discount offered, and the net price.” 58 TTABVUE 8:22-24. Mr. Wakeling personally orchestrated this deal, along with his sales representative. *Id.* at 10:10-11. The House was a vendor with which Mr. Wakeling had conducted many dealings in the course of his employment. *Id.* at 10:4. Even after a discount, the total amount due on the invoice was \$188,937.60, for 1,619 items. 36 TTABVUE (Exhibit 1 / BUR\_00264). At his trial deposition, Mr. Wakeling reviewed Exhibit 1 and confirmed that, to the best of his knowledge, all of the products sold in connection this invoice were FORUM products. 58 TTABVUE 11:4-8.

Similarly, Exhibits 2 and 3 are invoices dated November 19, 2013 and February 26, 2015 (respectively) of sales of FORUM products made to Sound Barrier, one of Registrant’s Vermont-based partners.<sup>11</sup> 36 TTABVUE 2 at ¶ 6. The sales prices were \$11,829.75 for 657 items (Exhibit 2) and \$2,353.17 for 117 items (Exhibit 3) after discounts. *Id.* (Exhibit 2 / BUR\_00259, Exhibit 3 / BUR\_00267).

As Mr. Wakeling emphasized, Exhibits 1, 2, and 3 to his testimony declaration are “just three representative examples of numerous sales of FORUM products during Burton’s fiscal years 2013 through 2017 that I was personally involved in and helped complete.” 36 TTABVUE 2-3 at ¶

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<sup>10</sup> Exhibit 1 reflects that the goods were shipped to The House in Shoreview, Minnesota 55126, and that The House’s business address is located in Saint Paul, Minnesota 55117. Burton’s First Notice of Reliance reflects that as of April 17, 2019, The House continued to sell FORUM-branded snowboards, boots, and apparel on its website. 41 TTABVUE.

<sup>11</sup> Exhibits 2 and 3 reflect sales of FORUM products as well as of products under different brands. 58 TTABVUE 14:21-23 (Exhibit 2), 18:15-17 (Exhibit 3). The first pages of these invoices in the “Ship To” and “Sold To” fields indicate that Sound Barrier is located in Rutland, Vermont 05701.

7; *see also* 58 TTABVUE 39:6-10 (“Q. So to the best of your recollection, might there have been other sales of Forum products in the years 2013, ’14 or ’15 besides what is reflected in Exhibits 5, 6 and 7? A. Definitely, yes.”). Based on the foregoing, the record plainly demonstrates that Registrant sold FORUM products in U.S. commerce in 2013, 2014, and 2015. *Id.* at 37:11-22. Registrant made such a sale as late as February 26, 2015, for the sale to Sound Barrier (36 TTABVUE, Exhibit 3) – almost 2.5 years after the October 2012 press release that Petitioner identifies as the occasion on which abandonment occurred.

3. *Petitioner’s Assertion That Registrant’s Sales Between 2012 and 2015 Are Not “Bona Fide Use in Commerce” Is Factually and Legally Unsupportable*

Citing no authority, Petitioner nevertheless argues that Registrant’s sales after October 12, 2012 do not constitute *bona fide* use in commerce of the marks:

Any sales after October 12, 2012 are merely “winding down” existing inventory in order for Registrant to “transition out of” the FORUM brand. Such sales connected to a winding down period are not *bona fide* sales sufficient to support the maintenance of a mark on the register because they are made only to recover costs, often at a liquidated value, and not with a *bona fide* intent to continue use of the mark in commerce.

61 TTABVUE 15. The first problem with Petitioner’s theory is that it lacks a factual basis. There is no evidence in the record that Registrant executed sales between 2013 and 2015 in order to “wind down” or that it applied discounted “only to recover costs.” Mr. Wakeling approved a 40% discount for the January 7, 2014 sale to the House (36 TTABVUE, Exhibit 1), which he characterized as “not really a high discount” for a prior year close out (PYCO) sale of “end of season product.” 58 TTABVUE 11:12-14 (“End of season product, it’s not a high discount. End of season, we traditionally would discount[.]”), 11:16-17 (“this is really not a high discount in the big scheme of things”), 12:21-23 (“it is not a high discount for product that is out of season”). Mr. Wakeling explained that he approved a 70% discount for the November 19, 2013 sale to Sound Barrier (36 TTABVUE, Exhibit 2) because it was “older product.” He further explained that he

approved an 83% discount for the February 26, 2015 sale to Sound Barrier (36 TTABVUE, Exhibit 3) “because it was a variety of products, broken size runs and the age of the product.” 58 TTABVUE 15:22, 20:1-3. Mr. Wakeling did *not* testify that he approved these discounts because Registrant was “winding down” the brand or simply trying to “recover costs,” nor is there any evidence in the record for that proposition. Petitioner’s unsupported and self-serving speculation as to the possible reasons why Registrant may have sold FORUM products at discounted prices in 2013, 2014, and 2015 is contradicted by the record, devoid of evidentiary value, and should not be considered by the Board.

Moreover, the Board should reject Petitioner’s fictitious theory that the sale of goods at discounted prices does not constitute *bona fide* use in commerce because this is emphatically *not* the law. “Use” of a mark means the “*bona fide* use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127. Recent Board precedent, in fact, suggests that the selling off of existing inventory does represent *bona fide* use in commerce. *See Double Coin Holdings, Ltd. v. Tru Dev.*, No. Cancellation 92063808, 2019 WL 4877349, at \*15, \*18 (TTAB 2019) (stating that “[f]rom May 2014 to April 2015, CMA sold out and exhausted its inventory of WARRIOR passenger car and light truck tires originating from Double Coin in China” and that, as a result, the petitioner failed to show three consecutive years of nonuse between April 16, 2015 and early 2018).

This is consistent with the Board’s determination that use in commerce contemplates “commercial use of the type common to the particular industry in question.” *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1018, 2018 WL 6923002, at \*3 (TTAB 2018). Mr. Wakeling testified that he had engaged in regular dealings with The House (58 TTABVUE 10:2-4) and that it was not uncommon to grant a discount to a vendor for end of season product. With regard to



Registrant's sales of FORUM products to Sound Barrier in 2013 and 2015, Mr. Wakeling explained that he negotiated the discounts with his counterpart and that, while he personally had not given a 83% discount to a buyer prior to the 2015 transaction, he knew of other occasions in which Registrant had "given high discounts before" and testified that the size and application of a discount "all depends on market conditions." *Id.* at 19:14-16. Mr. Wakeling's testimony is particularly authoritative and credible given that he was North American Sales Director between September 2011 and August 2012, he was responsible for all sales of FORUM products, whereupon he became U.S. Sales Director and still retained oversight over the FORUM brand until approximately May 2018. *See* 36 TTABVUE 1 at ¶ 2; 58 TTABVUE 58 7:24-8:1. There is not a scintilla of evidence to support any suggestion that Registrant's sales of FORUM products after October 12, 2012 were not legitimate, arms-length transactions.

For the foregoing reasons, Petitioner has failed to establish by a preponderance of the evidence that Registrant ceased use of the FORUM Marks as early as October 12, 2012.

**B. Petitioner Has Failed to Establish Three Years of Nonuse As of the Date He Filed the Petition to Cancel**

On January 26, 2018, Petitioner commenced the parent proceeding, Cancellation No. 92067794, alleging that Registrant had "abandoned and discontinued use of the . . . FORUM marks in commerce for more than three years, such abandonment was made with the intent to not use and to not resume use of the . . . FORUM marks." 1 TTABVUE 3 at ¶ 11. On February 23, 2018 Registrant answered and denied this allegation. 4 TTABVUE 2 at ¶ 11. Petitioner never moved to amend his pleadings before trial pursuant to Federal Rule of Civil Procedure 15(a).<sup>12</sup> As established in Section II.A *supra*, Registrant engaged in *bona fide* use in commerce of the

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<sup>12</sup> Federal Rule of Civil Procedure 15(a) is made applicable to *inter partes* proceedings via 37 C.F.R. § 2.116.

FORUM Marks as late as February 26, 2015. Thus, the evidence demonstrates that as of the time Petitioner commenced this proceeding on January 26, 2018, less than three years had elapsed since Registrant had engaged in *bona fide* use in commerce of the FORUM Marks.

Petitioner maintains that “Registrant had no sales at all for at least three years between at least February 26, 2015 and March 29, 2018,” meaning the period of alleged nonuse not only started years after the press release but ended after these proceedings were commenced. 61 TTABVUE 16. This argument, however, is foreclosed to Petitioner because it is “not within the issues raised in the pleadings,” nor has Petitioner ever raised it prior to trial or moved the Board to permit his pleadings to be amended pursuant to Federal Rule of Civil Procedure 15(b). Rather, Petitioner’s theory of the case has consistently been that Registrant abandoned the FORUM Marks in October 2012. The petition in the parent proceeding contains no allegation or well-pleaded facts about an alleged three-year period of nonuse beginning in 2015. In Cancellation No. 92069499 (subsequently consolidated with the parent proceeding), Petitioner repeatedly alleged that Registrant had abandoned the marks on or about October 23, 2012. 1 TTABVUE 3 at ¶¶ 9-12 (Cancellation No. 92069499). In his November 19, 2018 Motion for Summary Judgment, Petitioner did not allege that Registrant abandoned the FORUM Marks later than October 23, 2012, and cited the October 2012 press release in his Statement of Undisputed Facts as the occasion on which the marks were abandoned. 9 TTABVUE 2, § III.B. In his July 25, 2019 Response to Registrant’s Motion to Strike, Petitioner cited the October 2012 press release, and “related published articles, and interviews in 2012 and thereafter, the aggregate of which are believed by Petitioner to evidence an objective manifestation of Registrant’s intent to abandon use of the FORUM mark.” 17 TTABVUE 4-5. On September 30, 2020, Petitioner filed a Notice of Reliance attaching three printed publications dated October 23, 2012 – including the press release – and disclosed that he “will rely

on this web page to show that Respondent published an objective manifestation of its intent to abandon the Program Brands, including the Forum brand.” 24 TTABVUE 1-2 at ¶¶ 1-3. Also on September 30, 2020, Petitioner filed an additional Notice of Reliance attaching Registrant’s responses to certain Requests for Admission which were purportedly relevant to Registrant’s alleged abandonment of the FORUM Marks in October 2012. 25 TTABVUE 1-3 at ¶¶ 1-6.

The record is crystal clear. Until his opening trial brief, Petitioner *never* alleged or argued that Registrant’s period of nonuse of the FORUM Marks began any later than October 2012, let alone as late as 2015. Under such circumstances, Registrant expressly objects to Petitioner raising this new allegation at trial, and denies that his newly articulated theory of the case has been “tried by the parties’ express or implied consent.” Fed. R. Civ. P. 15(b)(2); *cf.* TBMP § 507.03(b) (“Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried.”). Fairness therefore dictates that the Board decline to consider Petitioner’s belatedly raised theory that Registrant’s period of alleged nonuse should be measured from February 26, 2015 through March 29, 2018, given that Registrant was not aware or fairly apprised until the filing of Petitioner’s opening trial brief – over 3 years after this proceeding was commenced – that Petitioner would seek to establish abandonment on this alternative theory. *See, e.g., Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 1339 (Fed. Cir. 1984) (motion to amend to add abandonment submitted after filing of trial briefs denied because the issue had not been tried); *accord Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1927, 2011 WL

2161071, at \*7 (TTAB 2011) (petitioner’s “family of marks” claim, raised for the first time in its brief not considered because it was “neither pleaded nor tried by the parties”).<sup>13</sup>

Registrant reasonably understood Petitioner to allege that its period of alleged nonuse began in October 2012. During discovery and through its testimony period, Registrant proffered sufficient evidence to deny that allegation and instead demonstrate that Registrant had engaged in *bona fide* use of the FORUM Marks well after October 2012 and within 3 years of Petitioner’s filing the petition. Had Registrant been fairly apprised that Petitioner would pursue an alternative theory of abandonment, it might have litigated this case differently during discovery. Abandonment based upon alleged nonuse beginning on February 26, 2015 is not an issue that was raised in the pleadings or that has been tried by the parties’ express or implied consent. The sole allegation in Petitioner’s pleadings and that the parties have litigated is whether Registrant ceased to use the FORUM Marks on and after October 2012. No reasonable view of the trial evidence supports this conclusion. On this basis alone, the petition to cancel should be denied.

**C. Petitioner Has Failed to Establish that Registrant’s Sale of FORUM Snowboards to The House Constituted “Token” Sales**

The record further indicates that Registrant entered into a deal with The House to sell FORUM snowboards (“Destroyer” and “Youngblood”) on a limited release in the winter of 2019. Mr. Wakeling corresponded with his point of contact at The House on March 29, 2018 concerning the terms of this deal. 36 TTABVUE 3 at ¶¶ 10-11; 40 TTABVUE, Ex. 5 (confidential). As Mr.

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<sup>13</sup> See also *Morgan Creek Prods., Inc. v. Foria Int’l, Inc.*, 91 U.S.P.Q.2d 1134, 2009 WL 1719597, at \*5 (TTAB 2009) (“The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter. This is especially true if the issue is purportedly tried solely through the plaintiff’s cross-examination of the defendant’s witness, since the plaintiff had the opportunity through its pleading to advise the defendant of the grounds it wished to pursue, and also had the opportunity, if new grounds came to its attention, to file a motion to amend the pleading under Fed. R. Civ. P. 15(a).”).

Wakeling testified, Registrant made and sold 100 snowboards at or near full price to The House for the following winter. 58 TTABVUE 22:16-23:4. Attached to the testimony declarations of Mr. Cunningham and Mr. Gaisser are the specifications dated March 1, 2019 depicting the Destroyer and Youngblood snowboards (FORUM products) that Burton sold to The House as part of this deal. 34 TTABVUE 3 at ¶ 10 & Ex. 4 (Cunningham); 35 TTABVUE 3 at ¶ 9 & Ex. 4 (Gaisser).

Citing no authority or record evidence, Petitioner maintains that this was a “token” transaction undertaken solely for the purpose of preserving Registrant’s rights in the marks:

Petitioner can’t prove it with smoking gun evidence, but it seems obvious that Registrant merely sold this token number of snowboards to one specific client (as opposed to a general market offering), for purposes of re-establishing rights in its abandoned FORUM marks. This sale therefore is not a *bona fide* sale since it does not genuinely comprise an effort to use the FORUM marks in the regular course of business as a legitimate proprietor would. . . . Petitioner, therefore, submits that the 2018/2019 token sale to The House should be excluded as not amounting to a *bona fide* sale in accordance with the Lanham Act.

61 TTABVUE 16-17. Petitioner’s assertion, once again, is contradicted by the record. Mr. Wakeling testified as to the reason he considered it important to engage in a deal with The House in 2018 and not two years earlier: “I always looked at Forum as a tool that I had to help gain sales, so in 2018, we needed sales. In 2016, the deal didn’t make sense for the sales that we were going to gain for it. . . . I was looking for additional sales and looking for longer term opportunity.” 58 TTABVUE 23:16-19, 24:4-5. In 2018, Mr. Wakeling “needed sales to hit [his] target at that point,” and he considered the 2018 deal to be “a leverage tool to get some more Burton products at the same time.” *Id.* at 24:11-12, 24:22-23. Thus, the record is clear as to why Registrant made the decision in and after March 2018 to sell 100 FORUM snowboards to The House. There is no factual basis for Petitioner’s contention that this was a “token” transaction.

Nor is this contention legally supportable. The sale of 100 manufactured snowboards to a Minnesota-based dealer and frequent customer of Registrant’s is not “sham” or “token” use.

Petitioner does not explain why he believes this transaction was not undertaken “in the regular course of business” or why he would have viewed it as legitimate had it been a “general market offering.”<sup>14</sup> The House was a dealer with which Mr. Wakeling had transacted business on numerous prior occasions, including with respect to the sale of FORUM products reflected in Exhibit 1 to his testimony declaration (invoice dated Jan. 7, 2014). 58 TTABVue 10:2-4 (“Did you conduct a lot of dealings with The House? A. Yes.”). A sale of 100 snowboards, undertaken for the purpose of generating future sales and gauging market interest in FORUM products, is far more than the “token use” that Congress was concerned about when it passed the Trademark Law Revision Act of 1988. See *Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768, 1994 WL 484936 at \*7 (TTAB 1994) (analyzing legislative history and explaining that a “token” sale or shipment had previously been “sufficient to lay a foundation for registration”), *aff’d*, *White v. Paramount Pictures Corp.*, 108 F.3d 1392 (Fed. Cir. 1997) (unpublished); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1993 WL 156479, at \*4 n.10 (TTAB 1993) (“The revision is designed to eliminate the practice of token use.”). Even assuming that the sale of 100 snowboards was not a large-volume sale, the Board has held that, as here, “*bona fide* test marketing and experimental sales in small volumes are sufficient to show use of a mark.” *Automedx, Inc. v. Artivent Corp.*, 95 U.S.P.Q.2d 1976, 2010 WL 3441114, at \*6 (TTAB 2010) (collecting authorities).

Under such circumstances, the Board should reject Petitioner’s contention that Registrant’s sale of FORUM snowboards to The House, which grew out of Mr. Wakeling’s negotiations beginning on March 29, 2018, was “token” use of the marks.

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<sup>14</sup> What Petitioner means by “general market offering” in the context of selling snowboards is also unclear.

### **III. Registrant Has Proffered Sufficient Evidence to Rebut Any Prima Facie Showing of Abandonment**

Assuming *arguendo* that Petitioner has proffered *prima facie* evidence of abandonment, he has nevertheless failed to carry his burden of persuasion of proving abandonment by a preponderance of the evidence because Registrant has produced more than sufficient evidence to demonstrate that it intended to resume use of FORUM during any period of nonuse.

#### **A. Registrant Intended to Resume Use of the FORUM Marks**

Mr. Wakeling was the North American Sales Director responsible for all sales of FORUM products between September 2011 and August 2012, whereupon he became U.S. Sales Director and still retained oversight over the FORUM brand until approximately 2018. 36 TTABVUE 1 at ¶ 2; 58 TTABVUE 7:16-8:1. He testified that “it was never [his] understanding that Burton intended to cease commercial use of FORUM” and that he instead “considered FORUM to be a valuable brand that could and would be utilized if the timing and situation were appropriate, particularly on a Special Make Up (SMU) basis.” 36 TTABVUE 2 at ¶ 3. Mr. Cunningham and Mr. Gaisser likewise testified that Registrant did not intend to cease commercial use of FORUM after 2012. 35 TTABVUE 2 at ¶ 4; 34 TTABVUE 2 at ¶ 4.<sup>15</sup>

The best evidence of Registrant’s intent to continue using the FORUM Marks is, of course, the ample evidence of its *bona fide* sales after October 23, 2012. The record reflects that substantial

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<sup>15</sup> Like Mr. Wakeling, Messrs. Cunningham and Gaisser have had deep involvement in overseeing the FORUM brand during the course of their employment. Mr. Gaisser has worked for Registrant since 1999, currently serving as Senior Director of Commercialization for Hardgoods. He was previously Business Unit Director – Boots from February 2002 to July 2016 during which time he worked on all of the boots for the FORUM brand. Petitioner declined to cross-examine Mr. Gaisser at trial. 35 TTABVUE 1 at ¶¶ 2-3. Mr. Cunningham has worked for Registrant since 2000, currently serving as Senior Vice President of Global Product. He was previously Vice President of Global Product, Vice President of Hardgoods, and Senior Business Unit Director for Boards and Bindings between 2011 and 2018. In these positions, he has been responsible for the teams that designed, produced, and developed all of the products sold and offered for sale under the FORUM brand. 34 TTABVUE 1-2, at ¶¶ 2-3.

domestic sales were made after that date and through the end of fiscal year 2017, and that a sale occurred as late as February 26, 2015. *See supra*, Section II.A. Moreover, Registrant sold 100 FORUM snowboards to The House on a limited release for the winter of 2019. *See supra*, Section II.C; *accord GSH Trademarks Ltd. v. Sia “Baltmark Invest”*, No. Cancellation 92066594, 2020 WL 205682, at \*9 (TTAB Jan. 10, 2020) [not precedential] (finding that “actions taken by Respondent and its agents within a relatively short time after the conclusion of the three-year statutory period of nonuse corroborate the existence of Respondent’s intent to commence use of its registered mark during the three-year nonuse period”). This conduct, without more, negates Petitioner’s allegation that Registrant intended not to resume use of the FORUM Marks after October 23, 2012.

Moreover, the evidence reflects that even after February 26, 2015, on multiple occasions Registrant sought out and evaluated potential deals to license the FORUM Marks. From April 2016 through June 2016, Messrs. Cunningham and Gaisser were closely involved in the evaluation of a potential deal to license FORUM to a third-party hard-goods manufacturer. Registrant requested and was provided an outline of such a licensing proposal, as well as a business plan, profit and loss statements, and other materials from this potential partner. Registrant’s senior management evaluated this proposal, including its then-President John Lacy. Ultimately, however, despite giving this proposal thoughtful consideration, Registrant opted not to enter such a licensing deal. 34 TTABVUE 2-3 at ¶¶ 5-9 & Exhibits 1-3 (public) / 38 TTABVUE 2-3 at ¶¶ 5-9 & Exhibits 1-3 (confidential); 35 TTABVUE 2-3 at ¶¶ 5-8 & Exhibits 1-3 (public) / 39 TTABVUE 2-3 at ¶¶ 5-8 & Exhibits 1-3 (confidential).

At or about the same time, in April 2016, Registrant evaluated a proposal to license FORUM to another third-party. Those discussions developed to the point that the third-party conveyed a licensing proposal to Mr. Wakeling via email dated April 7, 2016. 36 TTABVUE 3 at ¶



9 & Exhibit 4 (public) / 40 TTABVUE at 3 ¶ 9 & Exhibit 4 (confidential). Mr. Wakeling's point of contact proposed that Registrant exclusively license FORUM for use with sporting goods categories including snowboards, boots, and bindings; clothing and outerwear; bicycles and bicycle gear; footwear; eyewear; watches; and headphones and earbuds. *Id.* While Registrant opted not to enter into this proposed agreement, it represents yet another instance in which Registrant actively and seriously considered licensing FORUM throughout 2016.

Assessed as a totality, Registrant's evidence of *bona fide* sales in 2013, 2014, and 2015, and winter of 2019, and its efforts to evaluate licensing of FORUM in 2016 to multiple potential partners rebuts any presumption of abandonment that Petitioner may enjoy. These activities represent continuous and sustained efforts by Registrant to sell products under the marks and to market the brand to potential licensing partners. Under both Federal Circuit and Board precedent, the fact that Registrant sought out and evaluated licensing opportunities in 2016 is particularly persuasive evidence of its intent to resume use of the marks because this activity occurred nearly *two years* before Petitioner petitioned to cancel the FORUM Marks and *one year* before Petitioner's action sports company sought to "adopt" the FORUM Marks. 9 TTABVUE 3 (averring that Petitioner sought to "adopt" the '535 mark in April 2017). *See Crash Dummy Movie, LLC*, 601 F.3d at 1391 ("The Board may consider evidence and testimony regarding Mattel's practices that occurred before or after the three-year statutory period to infer Mattel's intent to resume use during the three-year period."); *Wirecard AG v. Striatum Ventures B.V.*, Cancellation No. 92069781, 2020 WL 973179, at \*9 (TTAB 2020) (crediting registrant's activities as establishing intent to begin use where such activity occurred before the petition to cancel was filed). Even though Registrant did not enter into these licensing deals in 2016, its decision not do so does not detract from the probative value of these activities, which demonstrate Registrant's intent to continue use of the FORUM

Marks. *See, e.g., Crash Dummy Movie, LLC*, 601 F.3d at 1391 (citing registrant’s “discussions” with a potential partner “about becoming the exclusive retailer of CRASH DUMMIES toys” and “consider[ation]” of “the relative merits of exclusive sales” as evidence that rebutted a presumption of abandonment, and stating that “[a]lthough Mattel did not ultimately enter into the KB Toys agreement, no evidence suggests that Mattel rejected the business opportunity because it decided to abandon the marks”); *Wirecard AG*, 2020 WL 973179, at \*9 (“The launch did not take place, but in view of the filing of the petition to cancel, the failure to launch does not detract from the activities demonstrating intent to commence use.”).

The foregoing evidence establishes that during any period of nonuse, Registrant intended to resume use of the FORUM Marks. This evidence is sufficient to rebut any presumption of abandonment.

**B. The October 2012 Press Release Should Be Accorded No Weight**

The overwhelming evidence of Registrant’s intent to continue or resume use of the FORUM Marks during any period of nonuse far outweighs the October 2012 press release, to which Petitioner attaches undue importance. Until the filing of his opening trial brief, Petitioner’s theory of the case has been that Registrant manifested an intent to abandon the FORUM Marks on October 23, 2012, through a press release stating, in part, that “[t]he company will exit out of The Program Brands in winter 2014 in order to better focus on and invest in Burton.” However, the trial record decisively cuts against that conclusion because Registrant did *not* stop making, selling, or offering for sale FORUM product, nor did it evince the intent to do so. The Board therefore need not, and should not, accord any weight to this press release because it need not make a finding as to Registrant’s intent as of October 2012 in light of the evidence that Registrant was engaged in continuous *bona fide* use of the marks for more than two years thereafter.

**C. If Deemed Admissible, the Testimony of Mr. Bost Should Be Accorded No Weight**

As Registrant has argued in its Separate Statement of Objections and Motion to Exclude, *see infra* Appendix A (“Motion to Exclude”), the purported expert opinions of Toby F. Bost should be precluded pursuant to Federal Rule of Evidence 702 and *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993). In the event the Board rules that Mr. Bost’s testimony is admissible, it should nevertheless accord that testimony no weight. The Board need look no further than Petitioner’s opening trial brief to determine that Mr. Bost’s testimony lacks probative value. Despite disclosing Mr. Bost’s opinions two years ago, Petitioner cited his testimony in only two sentences of his opening trial brief. 61 TTABVUE 18.

Petitioner plainly attaches little significance to Mr. Bost’s testimony, and for good reason. Because Registrant has proffered ample evidence of commercial use of the FORUM Marks after October 2012, Mr. Bost’s testimony regarding Registrant’s purported manifestation of intent not to use the marks after October 2012 lacks probative value. Moreover, for the same reasons articulated in Registrant’s Motion to Exclude, he is not qualified to testify as an expert in this proceeding. Mr. Bost’s testimony is infected by bias, unreliable, lacking in methodological rigor, and usurps the Board’s role as the trier of fact. Even if his testimony is admissible (it is not), the Board should accord it no weight.

**CONCLUSION**

WHEREFORE, for the foregoing reasons, Registrant, the Burton Corporation, respectfully submits that the Board DENY Petitioner’s petitions to cancel U.S. Registration Nos. 2,207,535 and 3,598,502, that the Board enter JUDGMENT for Registrant in Cancellation No. 92067794 (parent) and Cancellation No. 92069499, and afford such other and further relief as it may deem just and proper.

Date: June 14, 2021

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on June 14, 2021, a true and correct copy of the foregoing document entitled **REGISTRANT'S TRIAL BRIEF WITH APPENDIX A: SEPARATE STATEMENT OF OBJECTIONS AND MOTION TO EXCLUDE**, was served on Petitioner Joshua S. Schoonover, by emailing said copy to: lawgroup@coastalpatent.com.

/s/ Jennifer Parent  
Jennifer Parent

**APPENDIX A**

**REGISTRANT'S SEPARATE**  
**STATEMENT OF OBJECTIONS AND**  
**MOTION TO EXCLUDE**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Reg. No. 2,207,535 issued on December 1, 1998  
and Reg. No. 3,598,502 issued on March 31, 1999

Joshua S. Schoonover,	-----X		
	:		
	:		
Petitioner,	:		Cancellation No. 92067794 (parent)
	:		Cancellation No. 92069499
-against-	:		
	:		
	:		
The Burton Corporation	:		
	:		
Registrant.	:		
	-----X		

**SEPARATE STATEMENT OF OBJECTIONS AND MOTION TO EXCLUDE**  
**26 TTABVUE (DECLARATION OF TOBY F. BOST)**

Registrant objects to the admission into evidence of the Declaration of Toby F. Bost, 26 TTABVUE, pursuant to Fed. R. Evid. 702 and *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993). The *Daubert* doctrine provides that the federal tribunal must act as a “gatekeeper” to weed out junk science from being admitted into evidence under the guise of “expert” testimony.

Here, Petitioner offers Mr. Bost as an expert who will give the following opinions:

First, the phases [*sic*] “transition out of”, “transitioning out of”, “exit out of” or “exiting out of”, with respect to a brand, is a phrase that is often used in the action sports apparel and hardgoods business, and to “transition out” or “exit out” means, with respect to the brand, to stop making, selling and/or offering for sale, goods which bear the mark associated with the respective brand. With respect to a business, it would mean to cease activities of a business as a whole. In the instant matter, the phrase “transition out of” or “exit out of” is used in connection with The Program Brands, including Forum.

Therefore, it is my opinion that when The Burton Corporation made a public statement (Exhibits B&C, respectively) manifesting intent to “exit out of the Program Brands”, namely Forum, it was received by myself, and likely most or all in the field, that Burton was going to stop manufacturing and selling goods bearing these marks, specifically the Forum mark.

26 TTABVUE 2-3 at ¶¶ 10-11; 31 TTABVUE 31:22-24 (testifying that he offers two opinions in his testimony declaration). This testimony is inadmissible for several reasons.

*First*, Mr. Bost’s deposition testimony reflects that he is providing this testimony as a personal favor to Petitioner, who is his friend and former lawyer. Petitioner assisted Mr. Bost with patent work related to a skin care product that Mr. Bost tried to launch in approximately 2018. 31 TTABVUE 26:2-27:1. Mr. Bost did not disclose this relationship in his testimony declaration. When asked why he agreed to testify in this proceeding, Mr. Bost unpersuasively averred that he “felt like it was my civic duty to give [Petitioner] my opinion.” *Id.* at 28:5-6. However, Mr. Bost has never offered an opinion to any other person in any other legal proceeding besides this one. *Id.* at 28:15-18. In reality, Mr. Bost conceded that he was doing Petitioner a “favor” by testifying in this proceeding. *Id.* at 28:7-8. Since he was not receiving any compensation for this “favor,” Mr. Bost stated that he was doing it as an act of “charity” to Petitioner. *Id.* at 29:4-5. When pressed whether he engaged in other charitable activities outside of his professional work, Mr. Bost failed to identify any. *Id.* at 29:8-9 (“No specific charity work, you know, with any foundation or 501(c)(3) or anything like that.”). Unsurprisingly, Mr. Bost did not author his declaration; Petitioner did. *Id.* at 12:8-13.

Q. Mr. Schoonover authored the declaration, and you signed it?

A. Yes. That’s correct.

Q. You didn’t author any part of it; is that right?

A. That’s correct.

*Id.* at 12:16-21.

The Board should not consider “expert” opinions that the “expert” himself had no role in forming. Nor should the Board consider opinions that have been rendered in this proceedings as a



personal “favor” to the “expert’s” friend by a businessperson who is actively involved in building start-up businesses that may one day be competitive with Registrant. *Id.* at 53:7-19 (conceding that Mr. Bost’s business enterprise, Belvedere Capital LLC, is evaluating whether to invest in start-up business that could become competitive with Registrant). Experts should be free from bias and should do more than serve as the mouthpiece of a party. The Board should vindicate that principle by precluding Mr. Bost’s testimony.

*Second*, Mr. Bost is not qualified to offer any expert testimony. *See* Fed. R. Evid. 702 (providing that a “witness who is qualified as an expert by knowledge, skill, training, or education may testify in the form of an opinion” if the *Daubert* factors are satisfied). He has never acted as an expert in a legal proceeding before this one, ever sought out other opportunities to do so, or been approached by anyone besides Petitioner to act as an expert in another proceeding. *Id.* at 17:22-18:9. He has not authored any publications on any subject or taught any educational program of any kind. *Id.* at 18:14-20. Mr. Bost purports to be an expert in “action sports.” *Id.* at 33:14. But there is no reference source or any other kind of secondary source that would contain any list of phrases that bear a special meaning in this field. *Id.* at 51:8-13. He has no “scientific, technical, or other specialized knowledge [that] will help the trier of fact to understand the evidence or to determine a fact in issue.” Fed. R. Evid. 702(a). Mr. Bost’s ersatz expert testimony is nothing more than his personal belief regarding when Registrant manifested an intent to stop using the marks at issue in this proceeding. 31 TTABVUE 38:8-11. This is not the province of an expert. Because Mr. Bost is not an expert in any recognized field or subject, his declaration should be precluded.

*Third*, Mr. Bost’s testimony should be precluded because it is not “the product of reliable principles and methods.” Fed. R. Evid. 702(c); *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 141 (1999) (expert testimony is “admissible only if it is both relevant and reliable”). Here, Mr. Bost’s

testimony fails this standard because it is bereft of any methodological rigor and is based on speculation of what others in the action sports world may have thought Registrant's intent was regarding the FORUM Marks. While Mr. Bost's declaration states that the phrases "transition out of" and "exit out of" carry a special meaning and are "often used," he cited no other usages of these phrases in his declaration. 31 TTABVUE 32:14-21, 32:25-33:4. Nor could he recall instances in which any of the prior companies he worked for in the action sports field had ever used these phrases in a public statement. *Id.* at 50:10-51:7. There are no recognized or reliable sources, methods, or principles by which Mr. Bost's personal interpretation of these common phrases can be assessed. *Cf.* Fed. R. Evid. 702(d) (the expert must "reliably appl[y] the principles and methods to the facts of the case").

Mr. Bost's declaration further states that when Registrant used the phrases "exit out of the Program Brands" in the October 2012 press release, "it was received by myself, and likely most or all in the field, that Burton was going to stop manufacturing and selling goods bearing these marks, specifically the Forum mark." 26 TTABVUE 3 at ¶ 11. But Mr. Bost cannot possibly testify as to how other people "received" or understood the press release, and he admitted as much at his deposition. 31 TTABVUE 38:15-21 ("Q. You don't know whether all or most in the field share the same personal belief that you have held about this press release; is that right? A. Yeah. I, personally, don't know. Q. You don't know what anybody else personally believes about the press release, right? A. Yes. That's correct."). Nor did Mr. Bost make any effort to investigate or survey what other people understood the press release to mean. *Id.* at 38:22-25. Moreover, Mr. Bost acknowledged at his deposition that he also did not know whether Burton intended to stop making and selling goods bearing the FORUM Marks. *Id.* at 41:22-25 ("Q. You also don't know what Burton's intent was in terms of whether it would stop making and selling goods bearing the

Forum mark, right? A. That's correct. I was not – I did not know.”). At his deposition, Mr. Bost withdrew the entirety of his opinion articulated in paragraph 11 of his declaration.

*Fourth*, Mr. Bost's testimony should be excluded because it is not “based on sufficient facts or data.” Fed. R. Evid. 702(b). He has not reviewed any evidence in this proceeding aside from the October 2012 press release and an action sports publication describing the press release. 31 TTABVue 10:14-17, 41:17-21. He does not know the amount of Registrant's sales of goods under the FORUM Marks since 2012. *Id.* at 10:18-21. He does not know whether Registrant has undertaken any marketing activities in connection with the marks since 2012. *Id.* at 10:22-25. He does not know the amount of manufacturing of goods in connection with the marks since 2012. *Id.* at 11:1-4. He does not know whether Registrant ever planned to license or sell the FORUM Marks. *Id.* at 11:5-14. Mr. Bost has never seen the petition to cancel, Registrant's answer, or any other filings in the proceeding aside from his declaration, which he had not reviewed prior to his trial deposition since July 2019. *Id.* at 11:15-12:4. Notably, Mr. Bost testified that he would not have changed his opinions regardless of any other evidence that may have been produced in discovery. *Id.* at 13:5-22. No legitimate expert would refuse to consider unseen record evidence and refuse to modify his or her opinions to account for that evidence. Yet that is precisely what Mr. Bost stated at his trial deposition. The Board should refuse to consider Mr. Bost's testimony, which merely parrots the legal positions Petitioner has espoused in this litigation, without relying upon or considering the bulk of the record evidence.

*Fifth*, Mr. Bost's testimony should be precluded because it goes to the ultimate issues in the case and usurps the province of the trier of fact, which is capable of weighing the evidence and understanding the ordinary English language words that Mr. Bost claims carry a special meaning. Petitioner has proffered no evidence or authority that the trier of fact cannot comprehend the phrases

“transition out of” and “exit out of.” Even Mr. Bost conceded it was “possible” that laypeople were perfectly capable of understanding the meaning of those phrases. *Id.* at 33:23. Moreover, Mr. Bost’s opinions improperly invade the Board’s role of finding facts by purporting to testify as to Registrant’s intent to discontinue use of the FORUM Marks. Whether Registrant had such an intent is part of the legal analysis of Petitioner’s abandonment claim. It is simply inappropriate for Mr. Bost to offer legal conclusions as to an ultimate issue in the case, the disposition of which is solely reserved to the Board.

For all the foregoing reasons, Mr. Bost’s testimony should be precluded under Rule 702 and *Daubert*. The Board is perfectly capable of deciding the ultimate issues without receiving Mr. Bost’s unreliable and highly biased opinions into evidence. The Board has noted that “expert testimony is expensive and typically not utilized in Board proceedings.” *RTX Scientific, Inc. v. Nu-Calgon Wholesaler, Inc.*, No. Cancellation 92055285, 2013 WL 3168102, at \*2 (TTAB 2013). Petitioner cites no case in which expert testimony has been proffered (let alone admitted) in a Board proceeding to assist the trier of fact in determining a registrant’s “intent” to discontinue use of a mark. Nor does Petitioner cite a single case in any forum in which expert testimony has been proffered (let alone admitted), to explain the meaning of ordinary English-language terms and phrases which are accessible and comprehensible to the trier of fact. The Board should exercise its gatekeeping responsibilities here and preclude Mr. Bost’s testimony (26 TTABVue) in its entirety.

Date: June 14, 2021

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on June 14, 2021, a true and correct copy of the foregoing document entitled **REGISTRANT'S TRIAL BRIEF WITH APPENDIX A: SEPARATE STATEMENT OF OBJECTIONS AND MOTION TO EXCLUDE**, was served on Petitioner Joshua S. Schoonover, by emailing said copy to: lawgroup@coastalpatent.com.

/s/ Jennifer Parent  
Jennifer Parent

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